

Remarks

Objections and Rejections to Claims Based on "New Matter"

The claim amendments of 06 March 2003 were objected to under 35 U.S.C. §132 as introducing new matter into the disclosure. More specifically, the instant Action asserts the following phrases are unsupported by the originally filed specification:

"an integral, one-piece...mat...sealed on its surfaces and around its edges...with said water-proof cover extending over both sides of the cover material".

As an initial matter, Applicant respectfully notes that MPEP indicates that there exists "a strong presumption that an adequate written description is present when the application is filed" and that "an examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims."¹

In this light, Applicant indicates that support for the above-cited amendments is found in several places, in addition to the originally-filed claim 1 phrase "*sealed into one unit*" as noted in the instant Action:

(a) the many references to a "cover" or "covering material" that is sealed around a "core of Styrofoam or its equivalent" (e.g., the first and second paragraphs of the Detailed Description portion of the instant specification) clearly refer to a material that is sealed within a another material. Those of ordinary skill in the art understand what is meant by the term "core" (evidenced by the use of the term in USP 5,357,724 cited in the Background of the Invention section of the instant specification), namely one material *sealed on its surfaces and around its edges* by another material;

(b) similar reference is made to the air and water-tight seals formed about the edges of the mat;

¹ MPEP §2163 citing In re Wertheim, 541 F2d 257, 263, 191 USQ 90, 97

(c) support is also found in the U.S. Provisional patent application (Serial No. 60/179,107) to which the present application claims priority, which states "...The cover material is placed flat with the asphalt side up and the Styorfoam core is placed on the cover material...The cover sheet is now folded over the core forming a rounded edge...The three edges are now press rolled to seal the top and bottom asphalt sheets together." MPEP §2163.03(III) states that the claims in a US application are entitled to the benefit of ...the filing date of a provisional application if the corresponding...provisional application supports the claims in the manner required by 35 USC 112, first paragraph. If so desired, Applicant would be happy to amend the specification to reiterate this language, which clearly supports a claim for an integrated, one-piece mat sealed on its surfaces and enclosing the flexible core material in an air- and water-tight manner, if so desired by the Examiner, but respectfully submits that such amendment is not necessary.

In this light, Applicant respectfully requests reconsideration and withdrawal of this ground for objection and rejection of claims 1-11.

Rejections to Claims Based on Cited Art

Claims 1-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Onderak et al. (USP 4,403,009) in view of Juneau (USP 5,100,716).

Claim 1, through which each claim depends directly or through intervening dependent claims, has been amended to recite:

An icebreaker mat, comprising:

an integral, one-piece slip-resistant, non-adhering, flexible, water-proof mat including a flexible core material of substantially uniform thickness sealed air tight within a water-proof, flexible cover extending over the core material;

wherein said mat provides a safe and convenient method of eliminating ice; and

wherein the water-proof, flexible cover is non-adhering to ice.

The rejection based on the cited references is respectfully traversed in light of the present amendments, supported in the disclosure as noted above. Neither Onderak et al. nor Juneau teach

or suggest a *core* and *cover* configuration. Each of the cited references teach laminates comprised of multiple layers of various materials, not a *one piece* cover surrounding a flexible, foam core. Also, note that Onderak et al. require raised surfaces, whereas the present invention uses only textured surfaces to assist in preventing slippage. Onderak et al. are concerned about spills of liquids and have formed "dams" in their upper layer to handle such liquids and prevent the liquids from traveling to other areas of the airplane floor. Their surface is structured so that the shoes of people are raised above the level of the liquid, rather than being frozen on the surface where a person's foot would contact and break any ice that has formed.

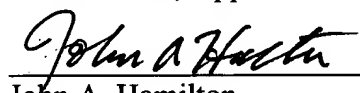
In addition to the arguments made above and in previous responses, evidence of commercial success is submitted herewith in Appendix A hereto in the form of a Rule 132 declaration and appended sales data related to a commercial embodiment of the invention. As discussed in the declaration, the presently claimed invention has been accepted with approval by end users through channels of trade, with the invention's value resting on its patentable features, consistent with claim language, and minimal other factors.

In light of the foregoing, Applicant respectfully submits that claims 1-10 are patentable over the cited art, and requests reconsideration and withdrawal of this ground for rejection.

Applicants respectfully submit that the above claims and remarks clearly establish the patentability of the claimed invention over the prior art. Favorable consideration and allowance are earnestly solicited. Should there be any questions after reviewing this paper, the examiner is invited to contact the undersigned at 617-854-4000.

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Respectfully submitted,
JOHN L. CARTIER, Applicant

By: 
John A. Hamilton
Reg. No. 48,946
Attorney for Applicant

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